

REMARKS

Reconsideration of the application is requested in view of the above amendments and the following remarks. Claims 2 and 4 have been cancelled, while any limitations included therein were added to claim 37. Support for the amendment to claim 37 can be found throughout the written description, such as page 12, lines 17-19; page 13, lines 6-16. Any claims formerly depending on claim 2 have been amended to depend from claim 37. In addition, claim 26 has been amended in an editorial fashion. No new matter has been entered in this amendment. Thus, claims 3, 6-26, and 37 are now pending.

Claim Objections

Claims 18 and 22 were objected to for failing to recite the method in which various properties of the eraser composition are calculated. In order to advance the prosecution of the application, Applicants have amended the claims to include the phrase "as measured according to JIS S6050" as requested by the Examiner. Applicants respectfully request the withdrawal of this objection.

Claim Rejection Under 35 U.S.C. § 112, ¶ 1

Claims 2-3, 6-10, 14-26, 30, and 37 were rejected under 35 U.S.C. §112, ¶ 2, for lack of enablement. Applicants respectfully traverse this rejection. In order to progress the prosecution of the application, however, the Applicants have added the limitations set forth in claim 4 to claim 37. Claim 4 was not included in this rejection, and it appears the Examiner determined that claim 4 satisfied the requirements of 35 U.S.C. § 112, ¶ 2. For at least this reason, Applicants respectfully contend the rejection has been rendered moot with respect to claim 37.

Claims 3, 6-10, 14-21, 23-26 and 30, depend from claim 37. For at least this reason, the rejection of these claims has also been rendered moot.

Claim 22 was also included in this rejection. Applicants respectfully traverse this rejection. The Examiner did not set forth his reasoning in issuing this rejection. With respect to the enablement requirement, the initial burden is on the Examiner to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). Moreover, the specification specifically discloses multiple compositions which can be used to create the invention disclosed in claim 22. (Please see page

22 of the specification). Accordingly, Applicants respectfully contend this rejection should be withdrawn.

Claim Rejection Under 35 U.S.C. § 112, ¶ 2

Claims 2-3, 6-10, 14-26, 30, and 37 were rejected under 35 U.S.C. §112, ¶ 2, as indefinite. Applicants respectfully traverse this rejection. In order to advance the prosecution of the application, however, the Applicants amended claim 37 to include all the limitations previously set forth in claim 4. The Examiner has already determined that claim 4 satisfies the requirements of 35 U.S.C. § 112, ¶ 2. Accordingly, claim 37 particularly points out and distinctly claims what the Applicants regard as their invention. Therefore, Applicants respectfully contend this rejection has been rendered moot.

Claims 3, 6-10, 14-21, 23-25, and 30 depend from claim 37. For at least this reason, these claims distinctly define the invention embodied in each of the claims. Applicants respectfully request the withdrawal of the rejection.

Claim 22 was rejected as indefinite. It appears the Examiner maintained the rejection on the same grounds set forth in the Office Action of January 22, 2003, that claim 22 is overly broad because it claims compositions by what they do rather than what they are. It is acceptable to claim materials based upon their structural properties, rather than their composition. *See In re Echerd*, 176 U.S.P.Q. 321, 322 (C.C.P.A 1973) ("There is nothing intrinsically wrong in defining something by what it does rather than what it is."). The limitations set forth clearly define what materials fall within the scope of the claim. Accordingly, Applicants respectfully contend that claim 22 satisfies the definiteness requirement of 35 U.S.C. 112, ¶ 2.

Claim 26 was rejected as employing an unacceptable claim format. Applicants respectfully traverse this rejection. To advance the application, however, claim 26 has been amended. The claim is written in accordance with U.S. patent practice. Accordingly, Applicants respectfully contend this rejection has been rendered moot.

Claim Rejection Under 35 U.S.C. § 103

Imashiro Reference

Claims 2-4, 7-11, 14-25, and 37 were rejected under 35 U.S.C. § 103, as obvious over Imashiro (U.S. Pat. No. 5,413,853). Applicants respectfully traverse this rejection. Claim 37 requires an eraser comprising an elastic material for erasing. This requirement is set forth in the

body of the claim, and therefore, is a necessary element of the claim. In addition, claim 37 requires this elastic material to be deposited in the void portions of a skeleton structure.

Imashiro is directed at a melamine resin foam having improved strength and water absorbability that can be used as a construction material having a very high flame retardancy. (Col. 1, ll. 10-40, Claim 1 of '853 patent). The reference is not in the same field of endeavor as the Applicants. Nor does the reference provide any indication that the foam taught therein would have any relevance to the problem that the current invention is directed. *See In re Oetiker*, 977 F.3d 1443, 1446, 24U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Accordingly, Applicants respectfully contend the Imashiro reference cannot be used in support of an obviousness rejection.

Moreover, Imashiro fails to teach or suggest that the melamine resin foam could function as an eraser. Nor does Imashiro teach that the voids in the melamine resin foam can be filled with an elastic material for erasing. In fact, Imashiro teaches against filling the void portions of the melamine resin foam. "The thus obtained foam must have substantially open cells because its skeleton is coated with a hydrophobic component as described later." (Col. 2, ll. 34-36). Since Imashiro fails to provide any motivation to use a melamine resin foam as an elastic material for erasing, Applicants respectfully contend Imashiro fails to render claim 37 obvious.

Claims 3, 7-11, 14-21, and 23-25 depend from claim 37, an allowable base claim. For at least this reason, these claims are also in condition for allowance.

Claim 22 requires an eraser having a surface hardness of 50 to 80 as measured according to JIS S6050, a sticking strength of 1.5 to 20 kgf, a coefficient of friction of not more than 0.8 and a wear rate of not less than 1 %.

As previously discussed, Imashiro does not fall within the Applicants field of endeavor, nor is it reasonably pertinent to the problem addressed by the current invention. Accordingly, Imashiro cannot be used in support of a § 103 rejection, and this rejection should be withdrawn.

Moreover, Imashiro fails to disclose a material having these structural properties. The Examiner argues that the melamine resin foam taught by Imashiro would inherently exhibit these structural properties once impregnated with rubber. Imashiro teaches a melamine foam which is exposed to a hydrophobic component that contains a silicon resin and a chloroprene rubber (Col. 2, ll. 37-41). These compositions would not inherently produce a foam having the structural properties required by claim 22. Nor is there any motivation to substitute these compositions

with materials that would produce an eraser having the claimed structural properties. Accordingly, Applicants respectfully request the withdrawal of this rejection.

Noboru Reference

Claims 2-4, 7-11, 23, and 37 were rejected under 35 U.S.C. § 103, as obvious over Noboru (JP 08-258493). These claims were also rejected under 35 U.S.C. § 102 as anticipated by Noboru. Claims 6, 14-22, 24, and 25 were also rejected under 35 U.S.C. § 103 as obvious over Noboru. Claims 26 and 30 were rejected under 35 U.S.C. § 103 as obvious over Noboru in view of Sturzenegger (U.S. Pat. No. 2,487,903). Applicants respectfully traverse all of these rejections.

Claim 37 requires that the eraser include a skeleton structure comprising a porous structural material comprising an organic polymer. Claim 37 further requires that the skeleton portion break from the eraser when a deformation force is applied. The broken-off skeleton portions, comprised of the organic polymer, thereafter become part of the eraser scrap along with the elastic material that has worn off the eraser.

Noboru is directed at an eraser having increased strength and durability. Noboru teaches an eraser device comprising a strong self-abrasive-type porous material. An inorganic material (such as boron nitride, talc, or mica) is included in this composite porous material. This inorganic material is distinct from the rubber base material used for erasing, and does not exhibit suitable erasing capabilities. When the eraser is rubbed, the inorganic material crumbles into pieces, like a pencil core, due to the frictional force applied against the paper. This eraser fails to exhibit the elasticity of the eraser of claim 37. (See current specification, p. 2-3). This reduced elasticity impairs the erasing capabilities of the eraser, since additional force is required to break down the inorganic material included in the porous material. The reduction in elasticity, and increased strength/hardness also results in an undesirable feel compared with conventional erasers. In addition, the inorganic material that rubs off reduces the efficacy of the erasing scraps generated by rubbing the eraser.

Nowhere does Noboru teach or suggest the use of an organic polymer as a skeleton structure. The organic polymer is a softer elastic material, thereby enhancing eraseability while providing for a smoother operating eraser that exhibits a better feel during use. This organic material, in combination with the softened, elastic material for erasing, affords a stronger scrap

collecting ability than that provided by the inorganic material taught by Noboru. Thus, Applicants respectfully contend Noboru fails to render claim 37 obvious.

Nor does Sturzenegger teach, or even suggest a skeleton structure having skeleton portions comprised of a structural material comprising an organic polymer. Sturzenegger is directed at a motor-driven adjustable eraser, and fails to provide any suggestion of a skeleton structure comprising an organic polymer. Thus, Sturzenegger fails to render claim 37 obvious for at least the same reasons as Noboru.

Claims 3, and 6-11, 14-21, 23-26, and 30 all depend from claim 37, an allowable base claim. For at least this reason, these claims are also in condition for an allowance.

Claim 22 requires an eraser having a surface hardness of 50 to 80 as measured according to JIS S6050, a sticking strength of 1.5 to 20 kgf, a coefficient of friction of not more than 0.8 and a wear rate of not less than 1 %.

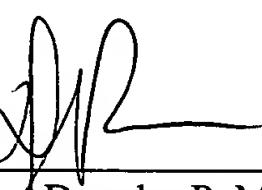
Nowhere does Noboru teach or suggest an eraser composition having the claimed structural properties. As previously discussed, Noboru is directed at an eraser having a stronger, tougher composition. Thus, Noboru teaches away from an eraser made of compounds exhibiting the claimed structural properties. In addition, since Noboru is directed at a tougher eraser, there would not have been any motivation to modify the eraser to include compositions exhibiting the claimed structural properties. Accordingly, the Applicants respectfully contend that Noboru fails to render claim 22 obvious.

In view of the above, Applicants respectfully requests reconsideration of the application in the form of a Notice of Allowance.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: April 22, 2004

By: 

Douglas P. Mueller
Reg. No.: 30,300
DPM/TSW